

REMARKS

Reconsideration of this application is respectfully requested in view of the foregoing amendment and the following remarks.

By the foregoing amendment, claims 1-3, 5-6, and 9 have been amended, and claims 10-12 canceled without prejudice or disclaimer for filing in a continuation application. Claim 4 was previously canceled. Thus, claims 1-3 and 5-9 are currently pending in the application and subject to examination.

Claim Rejection – 35 U.S.C. § 112

Claim 9 is rejected under 35 U.S.C. § 112, second paragraph, as lacking antecedent basis for “the parameter” in line 16. Applicants note that “the parameter” on line 16 is deleted in the present amendment. If any additional amendment is necessary to overcome this rejection, the Examiner is requested to contact the Applicants’ undersigned representative.

Claim Rejections – 35 U.S.C. §102

Claims 1-2 and 9-12 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,181,746 to Hoshi (“Hoshi”). It is noted that claims 1-3, 5-6, and 9 have been amended. To the extent that the rejections remain applicable to the claims currently pending, Applicants hereby traverse the rejections for the following reasons.

Applicants’ invention, as now set forth in amended claim 1, is directed to an MPEG video decoder for an MPEG bit stream which includes a sequence header, a first picture header immediately followed by first picture data, and a second picture header immediately followed by second picture data, wherein the first picture header, the second picture header, and the sequence header contain a first parameter, a second

parameter, and a third parameter, respectively, the MPEG video decoder comprising a first picture bank which stored first decoded picture data obtained by an image decoding section by decoding the first picture data; a first parameter bank which is associated with the first picture bank and stores the first parameter and the third parameter obtained by the image decoding section from the first picture header and the sequence header, respectively; a second picture bank which stores decoded picture data obtained by the image decoding section by decoding the second picture data; and a second parameter bank which is associated with the second picture bank and stores the second parameter and the third parameter obtained by the image decoding section from the second picture header and the sequence header, respectively; and a display control section which carries out a display control of the first decoded picture data stored in the first picture bank based on the first parameter and the third parameter stored in the first parameter bank, and carries out a display control of the second decoded picture data stored in the second picture bank based on the second parameter and the third parameter stored in the second parameter bank.

In applying Hoshi, the Office Action asserts Hoshi discloses a first parameter bank which is associated with the first picture bank and stores first parameters for displaying the first picture and a second parameter bank which is associated with the second picture bank and stores second parameters for displaying the second picture.

Applicants submit that Hoshi does not disclose, teach, or suggest an MPEG video decoder including at least a first parameter bank which stores the first parameter and the third parameter obtained by the image decoding section **from the first picture header and the sequence header**, respectively, and a second parameter bank that

stores the second parameter and the third parameter obtained by the image decoding section **from the second picture header and the sequence header**, respectively, as recited in claim 1.

To qualify as prior art under 35 U.S.C. § 102, a prior art reference must disclose each and every feature recited by a rejected claim. As noted above, Hoshi does not disclose, teach, or suggest each and every feature recited by claim 1.

For at least this reason, Applicants submit that claim 1, as amended, is allowable over Hoshi. For similar reasons, Applicants submit that claim 9 is likewise allowable over Hoshi.

Claims 2-3 and 5-8 depend from claim 1. It is respectfully submitted that these dependent claims be deemed allowable for at least the same reasons claim 1 is allowable, as well as for the additional subject matter recited therein.

Claim Rejections – 35 U.S.C. §103

Claims 1-3 and 5-12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,320,909 to Takabatake et al. ("Takabatake") in view of U.S. Patent No. 6,424,381 to Mendenhall et al. ("Mendenhall"). It is noted that claims 1-3, 5-6, and 9 have been amended. To the extent that the rejections remain applicable to the claims currently pending, Applicants hereby traverse the rejections for the following reasons.

In applying Takabatake, the Office Action asserts Takabatake discloses a first parameter bank which is associated with the first picture bank and stores first parameters for displaying a first picture in column 16, lines 9-31. However, column 16, lines 9-31 of Takabatake merely describes an arbitration function of adjusting address

generation timings. It appears that the Office Action equates the generated write addresses with the recited parameters. However, the generated write addresses are not stored into a predetermined first parameter bank associated with the first picture bank which stores a first parameter and a third parameter obtained by the image decoding section from the first picture header and the sequence header, as is recited in amended claim 1.

The Office Action also asserts that Takabatake teaches a second parameter bank which is associated with a second picture bank and stores second parameters for displaying the second picture in column 16. The Office Action does not identify a particular section or a particular element for the second parameter bank. Applicants submit that Takabatake does not disclose, teach, or suggest a second parameter bank which is associated with a second picture bank and stores a second parameter and a third parameter obtained by the image decoding section from the second picture header and the sequence header, respectively, as recited in amended claim 1.

Mendenhall, which is cited for teaching an internal buffer fails to cure the above-described deficiency in Takabatake.

To establish *prima facie* obviousness, the applied art of record must teach or suggest each and every feature of a rejected claim. See MPEP § 2143.03

As noted above, Takabatake and Mendenhall, alone or in combination, fail to disclose, teach, or suggest each and every feature of claim 1. Therefore, Applicants respectfully submit that claim 1 is not rendered obvious by any one or combination of Takabatake and Mendenhall, and should be deemed allowable. For similar reasons, Applicants submit that claim 9 is should likewise be deemed allowable.

Claims 2-3 and 5-8 depend from claim 1. It is respectfully submitted that these dependent claims be deemed allowable for at least the same reasons claim 1 is allowable, as well as for the additional subject matter recited therein.

With regard to each of the rejections under §103 in the Office Action, it is also respectfully submitted that the Office Action has not yet set forth a *prima facie* case of obviousness. The PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 U.S.P.Q.2nd 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002).

The Office Action merely states that the present invention is obvious in light of the cited references. See, e.g., Office Action at page 3. Applicants respectfully submit that such a statement is an insufficient showing of motivation.

CONCLUSION

For all of the above reasons, it is respectfully submitted that the claims now pending patentability distinguish the present invention from the cited references. Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. The fee for this extension may be charged to our Deposit Account No. 01-2300. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300 with reference to Attorney Docket No. 108391-00014.

Respectfully submitted,

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